

REMARKS

Reexamination and reconsideration of claims 1, 3-7, 11-16, 18, 23, 24, and 28, are respectfully requested. Claims 2, 8-10, 17, 19-22, 25-27, and 29-30 are withdrawn from consideration.

Claims 1, 3, 7, and 11 were rejected under 35 U.S.C. sec. 102(b) applying U.S. Pat. No. 5,408,562 (the '562 patent). The '562 patent discloses a submarine fiber optic cable for marine applications. See the Abstract and the Figures of the '562 patent. For a patent to be applicable under sec. 102(b), the patent must, *inter alia*, disclose each and every feature of the claimed invention.

It is respectfully submitted that the Office Action misinterpreted the '562 patent because each and every feature of claim 1 is not disclosed, taught, or otherwise suggested either explicitly, or inherently, by the '562 patent. In addition to previous arguments which will not be repeated here for the sake of brevity, Applicants wish to address the Response to Arguments section of the Office Action dated May 6, 2004. Specifically, the Response to Arguments section states, in part, the following at pp.5-6:

Applicant is not being persuasive by suggesting that the element 11 in '562 [U.S. Pat. No. 5,408,562] is not the equivalent of a duct when the claimed requirements of the applicants duct are to have an inner surface and outer surface, the inner surface provided with a cable, and a passageway between the inner and outer surfaces. The element 11 whether applicant considers it a hollow rod or a duct is immaterial when they both have the same structure and are therefore equivalent based upon the current claim language. It appears that applicant believes they are claiming closed passageways or that the duct has a solid outer surface however this is not the case and therefore the structure of element 11 meets the claim language.

First, besides making inaccurate and/or incorrect statements on the record, the Office Action is

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misinterpreting the recited structure of claim 1. Specifically, the original recitation of claim 1 recites "a duct tube," not "a duct" as suggested in the Office Action. See claim 1 of the present invention. It is not permissible for the rejection to ignore recited structural limitations as the Office Action is currently doing by interpreting "a duct tube" to mean "a duct."

Moreover, it is a well-settled that a sec. 102(b) rejection must disclose each and every feature of the claimed invention, rather than so called "equivalents" as suggested in the Office Action. To say that the recited structure of "a duct tube" and "a slotted rod 11" of the '562 patent are "...equivalent based on the current claim language" is incorrect and contradictory to the objective evidence of record. Simply stated, a rod is not a tube.

Second, the purported interpretation given in the Office Action to "a duct tube" is far beyond a reasonable broadest interpretation of the structure recited and instead perverts the plain and ordinary meaning of the recited "duct tube" structure. It is well-settled that Applicants' claims must be interpreted in light of the specification. In the present patent application, exemplary inner and outer surfaces 22a,22b along with passageways 24 of duct tube 22 are discussed and disclosed in the present application. See Fig. 2 and p. 5, 11.5-15. The purported interpretation of "the duct tube" given in the Office Action is absurd in light of the evidence. Moreover, it is an arbitrary and capricious interpretation not based upon any credible objective evidence of record.

Specifically, the Office Action is misinterpreting "a duct tube" as recited in claim 1 and confusing it with "the slotted rod 11" of the '562 patent. First, the two structures use different geometrical terms that describe

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different geometric structures. Second, the Office Action attempts to confuse and/or blur the meaning of "the slotted rod 11" of the '562 patent by referring to it as a "...hollow rod or duct...". The overwhelming objective evidence of record reveals that element 11 of the '562 patent is exactly that "a slotted rod 11," and not "a duct tube" as recited in claim 1. See the Abstract of the '562 patent.

The attention of the Primary Examiner is also directed to (slotted) rod 12 of U.S. Pat. No. 5,848,212 and central filament (slotted rod) 1 of U.S. Pat. No. 4,389,088, which disclose similar structures to "the slotted rod 11" of the '562 patent. See Col. 3, ll. 25-32 of the 5,848,212 patent and Col. 2, ll. 10-27 of the 4,389,088 patent.

As the evidence shows, it is beyond refute that the '562 patent states that element 11 is "a slotted rod" produced by an extrusion process. See Col. 5, ll. 37-39 of the '562 patent. Moreover, "...slotted rod 11 surrounds the wire 10 without leaving empty clearance spaces between the rod 11 and the wire 10." See the '562 patent at Col. 5, ll. 34-46. All of the objective evidence of record clearly states that "slotted rod 11" is formed by extruding plastic tightly over wire 10, thereby forming a solid composite slotted rod as is well-known in the fiber optic cable art. See Fig. 6 of the '562 patent. No reasonable broadest interpretation of "slotted rod 11" can anticipate "the duct tube" structure as suggested in the Office Action.

As further objective evidence of record, the '562 patent states "...a slotted rod 11 having peripheral helical slots 12...". See Col. 7, ll. 22-25 and Fig. 6 of the '562 patent. As known, the term periphery describes the external boundary or surface of a body. Thus, as explicitly stated by the '562 patent the slots 12 are formed on an outer surface of rod 11. Clearly this structure is not "a duct

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“tube” as recited in claim 1 and described and depicted in the present application. Thus, the objective evidence of the ‘562 patent completely contradicts the Office Action position and instead supports Applicants position. Likewise, the ‘562 patent does not teach other recited structure of claim 1 such as the passageway 24 disposed between the inner and outer surfaces 22a, 22b of “the duct tube.”

Furthermore, the purported broad interpretation of the term “duct tube” in the Office Action is incorrect and contrary to the objective evidence of record as discussed previously and herein. Moreover, the Office Action does not cite any credible text, Figures, or other objective evidence of record supporting its position of how “the slotted rod” is “a duct tube.” Instead, the Office Action makes unsupported conclusions in the rejection of the claims, rather than citing objective evidence of record. For at least the reasons stated, withdrawal of the sec. 102(b) rejection of claims 1, 3, 7, and 11 is warranted and respectfully requested.

Claims 1, 3, 7, and 11 were rejected under 35 U.S.C. sec. 102(b) applying U.S. Pat. No. 4,389,088 (the ‘088 patent). The ‘088 patent discloses an underwater fiber optic cable having a central filament (slotted rod) 1. See the Abstract of the ‘480 patent. For a patent to be applicable under sec. 102(b), the patent must, *inter alia*, disclose each and every feature of the claimed invention.

Again, it is respectfully submitted that the Office Action misinterpreted the ‘088 patent because each and every feature of claim 1 not disclosed, taught, or otherwise suggested either explicitly, or inherently, by the ‘088 patent. Simply stated, the ‘088 patent requires a slotted rod 1 having helical grooves provided at the peripheral

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surface. See the '088 patent at Col. 2, ll. 4-12. As stated above, the objective evidence is overwhelming that the slotted rod 1 is not "a duct tube" as recited in claim 1. For at least these reasons, as well as those stated above with respect to the '562 patent, withdrawal of the sec. 102(b) rejection of claims 1, 3, 7, and 11 is warranted and respectfully requested.

Claims 1, 3, 7, and 11 were rejected under 35 U.S.C. sec. 102(b) applying U.S. Pat. No. 5,848,212 (the '212 patent). The '212 patent discloses an optical fiber cable having a (slotted) rod 12 having grooves 14 in the outer peripheral surface. See the Abstract of the '212 patent and Col. 3, ll. 25-36. For a patent to be applicable under sec. 102(b), the patent must, *inter alia*, disclose each and every feature of the claimed invention.

It is respectfully submitted that the Office Action misinterpreted the '212 patent because each and every feature of claim 1 is not disclosed, taught, or otherwise suggested either explicitly, or inherently, by the '212 patent. As stated above, the objective evidence is overwhelming that rod 12 having grooves 14 is not "a duct tube" as recited in claim 1. Furthermore, no reasonable broadest interpretation can call rod 12 "a duct tube" as recited in claim 1. Simply stated, like the '562 and the '088 patents, there is not identity of invention between claim 1 and the '212 patent. For at least these reasons, withdrawal of the sec. 102(b) rejection of claim 1, 3, 7, and 11 is warranted and respectfully requested.

Claims 4-6, 12-16, 18, 23, 24, and 28 were rejected under 35 U.S.C. sec. 103(a) applying the '212 patent in view of U.S. Pat. No. 6,195,486 ('486). For patents to be applicable under sec. 103(a), the combination of teachings must, *inter alia*, expressly or inherently, teach, disclose,

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or suggest each and every feature of the claimed invention. Additionally, motivation and suggestion to combine the patents must be present.

First, as stated above, the '212 patent fails to disclose, teach, or otherwise suggest each and every feature of claim 1. Thus, the Office Action failed to make a *prima facie* case with respect to claims 4-6. For at least these reasons, the withdrawal of the sec. 103(a) rejection of claims 4-6 is warranted and respectfully requested.

Regarding claims 12-16, 18, 23, 24, and 28, neither the '212 patent, nor the '486 patent, alone or in combination disclose, teach, or otherwise suggest each and every feature of independent claims 12 and 24. As pointed out above, the slotted rod 12 of the '212 patent is not "a duct tube" as recited in claims 12 and 24. Likewise, "a slotted rod 75" of the '486 patent is not a duct tube as recited in claims 12 and 24. See Col. 6, 11. 33-45 of the '486 patent. Therefore, the Office Action has failed to make a *prima facie* case of obviousness with respect to independent claims 12 and 24. For at least these reasons, the withdrawal of the sec. 103(a) rejection of claims 12-16, 18, 23, 24 and 28 is warranted and respectfully requested.

Additionally, Applicants have not, and do not, acquiesce to combining of any of the references of record. Rather, the Office Action has failed to meet a threshold burden for making a *prima facie* rejection. Thus, arguing whether or not the skilled artisan would have been motivated or taken a suggestion to combine references is a moot point since the references clearly do not teach, disclose, or otherwise suggest each and every feature of the rejected claims. Moreover, the Reply states the claims are allowable over the purported rejection "[f]or at least these reasons...".

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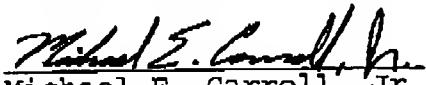
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No fees are believed due in connection with this Reply. If any fees are due in connection with this Reply, please charge any fees, or credit any overpayment, to Deposit Account Number 19-2167.

Allowance of all pending claims is believed to be warranted and is respectfully requested.

The Primary Examiner is welcomed to telephone the undersigned to discuss the merits of this patent application.

Respectfully submitted,

  
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